

**PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT
DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number
(Optional) 1594-
RUT.00-0084PCTA

First Named Inventor: LINDA M. BRZUSTOWICZ

International (PCT) Application No.: PCT/US01/13107

U.S. Application No.: n/a
(if known)

Filed: 23 April 2001

Title: METHODS AND COMPOSITIONS FOR THE DIAGNOSIS OF SCHIZOPHRENIA

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee
- (2) Proper reply
- (3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☒ Small entity - fee \$ 750.00 (37 CFR 1.17(m)). Applicant claims small entity status.
See 37 CFR 1.27.

☐ Other than small entity - fee \$ _____ (37 CFR 1.17(m))

01/17/2006 HKAYPAGH 00000161 10564260

04 FC:2453 2. Proper reply 750.00 OP

A. The proper reply (the missing 35 U.S.C. 371(c) requirement(s)) in the form of _____ (identify type of reply):

☐ has been filed previously on _____

☒ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

3. Terminal disclaimer with disclaimer fee

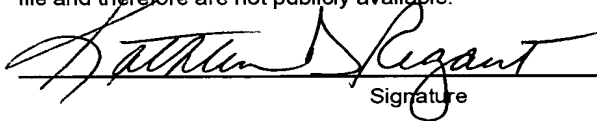
☒ Since this international application has an international filing date on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.


Signature

10 January 2006

Date

KATHLEEN D. RIGAUT, Ph.D., J.D.

Typed or Printed Name

43,047

Registration Number, if applicable

1601 Market Street, Suite 2400

Address

215-563-4100

Telephone Number

Philadelphia, PA 19103-2307

Address

- Enclosures: ☒ Response
☒ Fee Payment
☐ Terminal Disclaimer
☒ Other (please identify):

Declarations of Mr. Vincent Smeraglia; Linda M. Brzustowicz and
Anne S. Bassett

Transmittal Letter to the United States Designated/Elected Office
(DO/EO/US) Concerning a Filing Under 35 U.S.C. 371, including copy of
Form PCT/IB/308 and filing fee

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of)	Examiner: n/a
)	
Brzustowicz, L.M. et al.)	Art Unit: n/a
)	
Serial No.: PCT/US01/13107)	
)	
Filed: April 23, 2001)	
)	
For: "METHODS AND COMPOSITIONS)		
FOR THE DIAGNOSIS OF)	
SCHIZOPHRENIA)	

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT
DESIGNATING THE U.S. ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(B)

Dear Sir:

The above-identified PCT application having Serial No. PCT/US01/13107 (hereafter '13107 application) became abandoned for failure to file the national stage requirements (35 U.S.C. 371(c)) at the U.S. Patent and Trademark Office. Applicants submit that the failure to file the national stage requirements was unintentional and until recently, it was the belief of the undersigned that the Application could not be revived. The undersigned was recently made aware of certain facts associated with this abandonment and now respectfully requests that the Application be revived for the reasons set forth herein below. Declarations of Mr. Vincent Smeraglia and Drs. Brzustowicz and Bassett are also provided herewith in support of the present petition.

The '13107 application was filed on April 23, 2001 and claims priority to U.S. provisional application Serial No. 60/198/987 which was filed on April 21, 2000. At the time the '13107 Application was filed, Rutgers, the State university of

New Jersey (herein after "Rutgers") had also caused an additional 17 PCT applications to be filed directed to similar subject matter. Each of these PCT applications named Drs. Linda M. Brzustowicz and Anne S. Bassett as co-inventors.

As evidenced by the declaration of Drs. Brzustowicz and Bassett and copies of email communications between Dr. Brzustowicz and Mr. Vincent A. Smeraglia, Associate Director at the Office of Corporate Liaison and Technology Transfer, Rutgers, The State University, which are submitted herewith, within the last year, Drs. Brzustowicz and Bassett became aware that Rutgers had failed to file the national stage requirements for the '13107 application by December 21, 2001 thereby resulting in abandonment of the US National phase application. The undersigned is in the process of having a Declaration executed by Dr. Brzustowicz which will be forwarded to the USPTO to supplement this request immediately upon receipt. Dr. Bassett has already executed the Declaration.

Drs. Brzustowicz and Bassett had no intention whatsoever of abandoning the application as set forth in their Declaration attached hereto. The inventors were of the belief that the filing requirements had been met and that everything was in order with the filing.

As stated in the Declaration of Mr. Vincent Smeraglia, then an employee of Rutgers tech transfer office, in November of 2002, the undersigned was contacted and provided instructions to allow all Brzustowicz applications to lapse. These instructions were in error as it was the intention of the office and the named co-inventors to pursue the '13107 application directed to an alternative splice variant of the CAPON gene associated with schizophrenia. In addition, these instructions were given without communication to Drs. Brzustowicz and Bassett. This miscommunication is evidenced by copies of emails exchanged

between Dr. Brzustowicz and Mr. Smeraglia attached hereto. The undersigned was only recently made aware that Drs. Brzustowicz and Bassett had no knowledge of the abandonment of the application and moreover had been made to believe the application was pending before the USPTO. The undersigned was made aware of this situation in November of 2005.

The MPEP at §711.03(c) clearly indicates that, upon a petition under 37 CFR 1.137(b) and sufficient evidence, an unintentionally abandoned international application designating the U.S. should be revived. Clearly, the facts set forth above and the Declarations attached hereto provide clear indication that the abandonment of the '013107 application was unintentional on behalf of the named co-inventors. Notably, no assignment document was executed in this case, thus the present inventors clearly hold all rights in the present invention.

Applicants hereby state that the entire delay in filing the national stage requirements under 35 U.S.C. 371(c) at the U.S. Patent and Trademark Office from the due date for the requirements under 35 U.S.C. 371(c) until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Accordingly, Applicants request the above-identified international application be revived. Also submitted herewith are the necessary papers and fee for entering the US National Phase.

Respectfully submitted,

DANN, DORFMAN, HERRELL AND SKILLMAN

A Professional Corporation

By 

Kathleen D. Rigaut, Ph.D., J.D.

PTO Registration No. 43,047

Telephone: (215) 563-4100

Pat Appl No.: PCT/US01/13107

Request for Revival

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of)

Brzustowicz, L.M. et al.)

Serial No.: Not yet assigned)
[Int. Appl.No.:PCT/US01/13107])

Filed: April 23, 2001)

For: "METHODS AND COMPOSITIONS)
FOR THE DIAGNOSIS OF)
SCHIZOPHRENIA)**DECLARATION OF MR. VINCENT SMERAGLIA**

I, Vincent Smeraglia hereby declare that:

1. I was employed by Rutgers, the State University of New Jersey (hereafter "Rutgers"), and worked as an Associate Director of Technology Transfer at its Office of Corporate Liaison and Technology Transfer (OCLTT) during the period from November 14, 1998 to April 22, 2005.

2. At and around January 20, 2000, Drs. Linda M. Brzustowicz and Anne S. Bassett disclosed to us their research results on localization of a genetic locus on chromosome 1 associated with increased prevalence of schizophrenia and genes residing in that locus. Based on these results and under our instruction, a provisional application, Serial No. 60/198,987 (hereafter, '987 application) and a PCT application, PCT/US01/13107 (hereafter, '13107 application) were filed by Dann Dorfman Herrell and Skillman P.C. at Philadelphia, on April 21, 2000 and April 23, 2001, respectively

Pat Appl No.: PCT/US01/13107

Request for Revival

3. Due to a clerical error at the OCLTT, our office erroneously directed Dann, Dorfman, Herrell and Skillman to allow the '13017 application along with 16 other applications directed to similar subject matter to become abandoned by not filing a Chapter II Demand nor entering the National phase at 20 months from the earliest effective priority date.

4. This failure to attend to filing of the national stage requirements (35 U.S.C. 371(c)) at the U.S. Patent and Trademark Office was not communicated to Drs. Brzustowicz and Bassett until January of 2005.

5. As evidenced by an email dated January 10, 2005, there was some confusion at our office as to the pendency of the above-described application which we subsequently discovered had become abandoned. Clearly, this failure to file the national stage requirements (35 U.S.C. 371(c)) at the U.S. Patent and Trademark Office for the '13107 application by December 21, 2001 was due to a misunderstanding in our office and was unintentional. Accordingly, it is respectfully requested that this petition for revival of the application be granted.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the above-referenced application or any patent issued thereon.

1/9/2005
DATE

Vincent Smeraglia
Vincent Smeraglia

10/564260

Janice Nightlinger**From:** Brzustowicz, Linda [Brzustowicz@Biology.Rutgers.Edu]**Sent:** Tuesday, November 01, 2005 5:44 PM**To:** Kate Rigaut**Subject:** FW: Patents

AP20 Rec'd PATENT 10 JAN 2006

I can see if I can find other evidence that I was under the impression that the CAPON provisional had been converted, but maybe this is a good start?

From: Smeraglia, Vincent [mailto:smeraglia@oclitt.rutgers.edu]**Sent:** Monday, January 10, 2005 5:31 PM**To:** Brzustowicz, Linda**Cc:** Didonato, Joseph**Subject:** RE: Patents

Linda:

There is a some confusion here at our office. I also originally thought we left the original patent application as well as the CAPON sequence application proceed. We did withdraw a bunch of applications from proceeding so they would not publish and we could keep our options open in terms of future filing. I can't find record of the CAPON case publishing online which may mean we can resubmit the case as well as file a third application on your newest discoveries. Let us do some digging around and give you an update.

Vince

Vincent A. Smeraglia
Associate Director, Intellectual Property
Office of Corporate Liaison and Technology Transfer
Rutgers, The State University
3 Rutgers Plaza, ASB III
New Brunswick, New Jersey 08901
Phone: (732) 932-0115, extension 3021
Facsimile: (732) 932-0146
Electronic mail: smeraglia@oclitt.rutgers.edu
Website: <http://oclitt.rutgers.edu>

Pat Appl No.: PCT/US01/13107

Request for Revival

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of)	Examiner: n/a
)	
Brzustowicz, L.M. et al.)	Art Unit: n/a
)	
Serial No.: Not yet assigned)	
[Int. Appl. No: PCT/US01/13107])	
)	
Filed: April 23, 2001)	
)	
For: "METHODS AND COMPOSITIONS)	
FOR THE DIAGNOSIS OF)	
SCHIZOPHRENIA)	

DECLARATION OF LINDA M. BRZUSTOWICZ AND ANNE S. BASSETT

We, Linda M. Brzustowicz, and Anne S. Bassett, hereby declare that:

I. We are the co-inventors of the invention described and claimed in PCT Patent Application Serial No.: PCT/US01/13107, (hereafter '13107 application), filed on April 23, 2001 designating the US which claims priority to U.S. Provisional Patent Application Serial No.: 60/198/987 (hereafter '987 application), which was filed on April 21, 2000.

II. The '987 and '13107 applications describe the results of our work on localization and characterization of genes associated with the schizophrenia phenotype. The '987 provisional application and the '13107 PCT application were both filed through the Office of Corporate Liaison and Technology Transfer at Rutgers, the State University of New Jersey (hereafter "Rutgers").

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III. Rutgers was named as Applicant for all designated States except the U.S.

IV. Because no assignment for the '13107 application or the previous '987 provisional application, has been executed, we are the co-owners of the subject matter disclosed and claimed in the '13107 application.

V. It was our understanding and belief that, on our behalf, Rutgers has been active in pursuing patent prosecution of the '13107 application in the U.S.

VI. However, on or about January 10, 2005 we became aware that the '13107 application became abandoned in the U.S. on December 22, 2001 as Rutgers failed to timely file the national stage requirements (35 U.S.C. 371(c)) at the U.S. Patent and Trademark Office. See email correspondence between Dr. Brzustowicz and Mr. Vincent Smeraglia attached hereto.

VII. We never intended to abandon the invention disclosed and claimed in the '13107 application. Moreover, we were never provided the option to pursue patent protection on our own as we were under the impression that the application was proceeding normally through the USPTO. We, therefore, respectfully request that our petition for revival of this application be granted.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or

10/564260

Pat Appl No.: PCT/US01/13107

Request for Revival

AP20 Rec'd 10 JAN 2006

imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the above-referenced application or any patent issued thereon.

DATE

Brzustowicz, Linda M.

DATE

Bassett, Anne S.